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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|---------------------|------------------|
| 09/878,860  | 06/09/2001  | George Michael Mockry | 530.005PA           | 8653             |
| 22907   | 7590        | 02/16/2006            | EXAMINER            |                  |
| BANNER & WITCOFF<br>1001 G STREET N W<br>SUITE 1100<br>WASHINGTON, DC 20001 |             |                       | CHAMBERS, MICHAEL S |                  |
|   |             |                       | ART UNIT            | PAPER NUMBER     |
|   |             |                       | 3711                |                  |

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/878,860             | MOCKRY ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Mike Chambers          | 3711                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 January 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 23-25,27-30 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 23-25,27-30,32-40 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25, 28-30, 33-35 37-38 and 40 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over ProQuest-Producing Sports Channel (pages 1-3). ProQuest discloses an edited baseball game provided to subscribers. The method claimed would naturally be used during the production and showing of the condensed game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have selected an appropriate number of action shots recorded including substantially every pitch from a <sup>first</sup> ~~fist~~ pitch to the last pitch together with other action occurring during a game in order to permit the edited video to be broadcast in an allotted time.

As to claim 24: See claim 23 rejection. The decisions to record each appearance at bat for every player, the final pitch thrown to each player and successful and

unsuccessful attempts by the base runners are design choices based on editing decisions by the editor or time available for broadcast. The specification provides no unexpected or surprising results in recording the action plays of the game. It would have been obvious to one of ordinary skill in the art at the time of the invention to have edited the video to reflect what the editor wished to record based on personal preferences and time available. The method claimed would naturally be used when the video was produced and played.

As to claim 25: No criticality is seen in the duration of the edited recording. The duration of the edited recording is a matter of design choice. The specification provides no unexpected or surprising results in using an edited recording of 15 minutes. It would have been obvious to one of ordinary skill in the art to select an appropriate length of time for the video to run based on cost and design considerations. The method claimed would naturally be used when the video was produced and played.

As to claim 28: The method claimed would occur naturally when the edited video tape was played. It would have been obvious to one of ordinary skill in the art to have included the method of playing the video tape since this is one of the logical reasons for producing the video. The method claimed would naturally be used when the video was produced and played. There is no patentable novelty in broadcasting a video. The means for display is a matter of design choice. The specification provides no unanticipated or surprising results from the various means of display chosen.

As to claim 29: ProQuest discloses an edited recording. Since the recording is broadcast, the inclusion of audio would naturally occur. No criticality is seen in the audio

containing an explanation of any substitution of players. It would have been obvious to one of ordinary skill in the art to have included appropriate commentary in order to keep the viewer updated with accurate information and avoid viewer confusion. The method claimed would naturally be used when the video was produced and played.

As to claim 30: See claim 25 rejection. The specification provides no unanticipated or surprising results from the time limitation claimed, therefore this is considered a design choice. It would have been obvious to one of ordinary skill in the art to have selected any group of equivalent times based on the desired times for showing the edited video.

As to claim 33: See claim 28 rejection.

As to claims 34,37 and 40: See claim 29 rejection.

As to claims 35 and 38: ProQuest discloses a premium subscription service (pg 2-paragraph 7). The method of obtaining additional revenue would naturally occur when subscribers opted for the premium service over the basic service.

Claims 27, 32, 36 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over ProQuest as applied above and further in view of MediaChannel. MediaChannel discloses it is well known in the art to broadcast sports videos over the internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the broadcasting method of MediaChannel in order to increase the number of people subscribing to the service.

***Response to Arguments***

Applicant's arguments filed 1/25/06 have been fully considered but they are not persuasive.

With regard to the complaint that the PTO has un-necessarily delayed this application and caused the inventor needless expense the following should be noted:

- 1) The original application was reviewed and a notice of allowance was issued for a narrowly drawn claim based on the search and references of record available at that point of time.
- 2) The applicant filed a petition to correct the filing date which placed the parent application in "limbo" while the petition was considered. The examiner had no input or discussion in this delay.
- 3) During this petition delay, a child application with very broad claims was filed.
- 4) In reviewing this child application, the office rejected the claims as submitted.
- 5) Since the parent application had not issued, the PTO had a responsibility to review the parent application in light of the art used to reject the child application. A subsequent decision was made on the parent application that the cited art also read on the previously allowed claims. The notice of allowance was rescinded and additional office actions were conducted in light of this new art.
- 6) During the pre-appeal conference requested by the applicant, new art was presented by one of the reviewers. It was felt that the currently constructed claims read in a 102 or 103 fashion on the existing claims. This resulted in the withdrawal of finality and the issuing of a new rejection. If the currently cited art had been found prior to the original issuing of a Notice of Allowance, it would not have been issued.

7) This final rejection should finally place the application in condition for review by the Board of Appeals should the applicant wish to pursue this course of action.

With regards to the applicant's assertion that his instant invention is not a mere "highlights" of the game. The definition of highlights is as follows from the Merriam-Webster on-line dictionary.

high·light Function: *noun*

2 : something (as an event or detail) that is of major significance or special interest.

Both the instant invention and the ProQuest invention show "highlights" of the game. Given this recording of "highlights" the question comes down to is it novel to "condense" a video? ProQuest clearly shows that the editing of a complete game was known in the art prior to the instant invention. Then the question comes down to whether the selection of 20 or 15 minutes as an editing time is patentable. One of ordinary skill in the art would naturally select any number of highlights ranging from only one highlight to recording all of the game. Again recent case law indicates that merely changing a limitation in a claim without surprising or unexpected results is considered an obvious design choice and not a patentable feature.

As noted in the following case, the applicant appealed a decision that found the number of holes in a weight was an obvious choice to one of ordinary skill in the art.

*Iron Grip Barbell v. USA Sports* (Fed. Cir. 2004).

Iron Grip is the assignee to U.S. Patent No. 6,436,015, which covers a weight plate with a triad of dispersed grip locations. USA makes allegedly infringing plates. The district court granted USA's motion for summary

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judgment that the patent was obvious, finding that "it would have been obvious to a layman to combine the prior art." On appeal, the Federal Circuit affirmed:

Because the claimed invention falls within a range disclosed in the prior art, and the patentee has not shown that the prior art taught away from the invention or new and unexpected results from a three elongated grip weight plate as compared to those in the prior art, we conclude that the claims are obvious absent substantial evidence of pertinent secondary factors supporting patentability.

Finding of obviousness affirmed

As noted in the prior office action, the applicant is merely taking a well known operation "editing and showing a sport's video" and claiming novelty. As noted in the case below, one skilled in the art is assumed to be knowledgeable, and ~~and not to have~~  
~~the application~~ would seem to indicate one of ordinary skill in the ~~the~~  
~~the~~

In re Sovish, Moisson, and Selleslags (CAFC 226 USPQ 771 July 26, 1985, 85-781) the court found the argument that the propriety of combining references was proper for one skilled in the art:

Appellants have argued at length about the "propriety" of "combining the two references" as though the question is simply whether the Esher patent suggests within its four corners using the disclosed tubular, closed-end plug in a heat recoverable aperture member or conduit or whether Weagant similarly suggests using art Esher type plug in place of cork-like plug 26. That is not the proper approach to the issue, which is whether the hypothetical person of ordinary skill in the relevant art, familiar with all that Esher and Weagant disclose, would have found it obvious to make a structure corresponding to what is claimed See Kimberly-Clark Corp. vs.: Johnson & Johnson, 745 F.2d 1437, 1449, 223 USPQ 603 610 (Fed. Cir. 1984). We conclude that such hypothetical person would have found obvious what claim 1, for example, delineates, applying such "ordinary skill" as he (or she) is presumed to possess. Finally, appellants contend that even if it were proper to "combine" the references, whatever they may mean by that, they would "neither meet the terms of the appealed claims nor result in a useful device." The question here, however is not meeting the terms of the claims. The rejection is for obviousness of what is claimed, which involves consideration of the ordinary skill of the art. As for resulting in a useful device, appellants are talking about Esher's plug not being removable and being left in the conduit which, they say, "would prevent effective heat recovery." They are assuming that one of ordinary skill would not appreciate that Esher's hollow member 14 could be removed if it is

not wanted, a insulation or otherwise, and that it would not be removed by a skilled worker who wished to allow heat recovery of the conduit in which it was placed. This argument presumes stupidity rather than skill.

The decision of the board is affirmed

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael Chambers  
Examiner  
Art Unit 3711

February 9, 2006



EUGENE KIM  
SUPERVISORY PATENT EXAMINER